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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/607,010

06/26/2003

Ed Austin

39262/285776

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30559

7590

08/07/2006

CHIEF PATENT COUNSEL
SMITH & NEPHEW, INC.
1450 BROOKS ROAD
MEMPHIS, TN 38116

EXAMINER

SHAFFER, RICHARD R

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/607,010	Applicant(s) AUSTIN ET AL.	
	Examiner Richard R. Shaffer	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 6-15, 22, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 16-21, 23-25 and 28-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

The amendment filed on May 15th, 2006 to claim 3 corrects for the previous objection and is hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 16-19, 21, 23, and 30-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Faccioli et al (PCT Publication WO 00/40163).

Faccioli et al disclose an external fixation apparatus comprising: a first member (3) attachable to the tibia (**Figure 2B**) by pins (5); a second member (20 and 35, optionally 2 as well) coupled to the first member (through member 2) through a lockable ball joint (top of 2, bottom of 3, **Figure 2B**); the stem (20, 35) is directly adjacent to a pin clamp with first jaw (40) and second jaw (50); wherein the stem can be translated relative to its longitudinal axis when connected due to the two ball joints in the system or freely when not attached (can be moved in any direction for that matter); can be locked through screw/first bolt (43) that passes through an opening in the first (40) and second (50) jaws; second and third (59) bolts hold the two jaw parts together; the pin clamp is attachable to a talus or calcaneus; a hole (38) within the first jaw (40)

In regard to claims 5, 16, 18, 19, 21, 23 a first interpretation of the stem member could include both element **20** and element **35** thereby creating a single prong. In this case, the pin clamp would rotate about the second end of the stem. A second interpretation would treat element **20** as the stem and element **35** as the shaft. Shaft (**35**) has two grooves located circumferentially (as well as having an individual length about the circumference) to allow locator pins (**37**) to pass through to couple the pin clamp to the stem (**20**). It is inherent that to decouple the components, locator pins (**37**) would be pulled out.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faccioli et al in view of Wagenknecht (US Patent 5,160,335).

Faccioli et al disclose all of the claimed limitations except for the use of biasing elements received within the openings of the two jaws. Wagenknecht teaches (**Column 6, Lines 37-43**) that the use of springs (**Figure 6**) in the openings of jaws facilitate the introduction of pins through a clamp intended to connect bone. This is the same motivation set forth by applicant for using springs or other biasing elements in the current application. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include springs or an equivalent biasing

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element in the device of Faccioli et al to facilitate the introduction of bone pins through the clamp.

Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faccioli et al in view Lee et al (US Patent 5,405,347).

Faccioli et al disclose all of the claimed limitations except for a stem body with a carriage fitted within operated by keybolts. Lee et al teach (entire disclosure) a device that allows for angular and lateral adjustment of fixator rods in an infinite number of planes and is operable by screws. The benefit cited by Lee et al was that a surgeon could perform minor readjustments to fully align bone fragments without disconnecting the device. It would have been obvious to one having ordinary skill in the art to have provided the device of Lee et al between elements (2 and 20 / replacing the ball-and-socket joint found there) to allow for minor adjustments to fully align bone fragments without detaching the device from itself or the bone pins.

Response to Arguments

Applicant's arguments filed May 15th, 2006 have been fully considered but they are not persuasive. In response to applicant stating the amended claims have limitations not found within Faccioli et al, applicant is directed to the current rejections above. In response to Faccioli et al not where the first and second ends of the stem can be translated transversely relative to the longitudinal axis, due to the ball joints, even connected, it can be translated transversely in any direction perpendicular to its longitudinal axis. Further as mentioned earlier, applicant has not had any positive

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limitation that the piece must move while attached to adjacent components. Of course one if so desired could move the first and second ends together in any direction.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richard Shaffer

Richard Shaffer
August 2nd, 2006


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER